

REMARKS

New claims 18-37 are all of the pending claims. By this amendment claims 1-17 have been cancelled. Claims 18 and 35 are independent claims.

Formal Matters

Applicant thanks the Examiner for indicating acceptance of the drawings filed July 2, 2004.

Applicant also thanks the Examiner for acknowledging the claim for foreign priority and confirming receipt of the certified copy of the priority document from the International Bureau.

Finally, Applicant thanks the Examiner for considering and initialing the Information Disclosure Statement filed July 2, 2004.

Claim Rejection Under 35 U.S.C. § 112

Claims 1-3 and 9-11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is moot in view of the cancellation of these claims.

Claim Rejection Under 35 U.S.C. § 103

Claims 1-3 and 9-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kosova, US Patent 4,492,046.

Claim 18

New independent claim 18 is substantially based on original claims 1-3.

Examples of this new claim are shown from the original specification (see for instance FIGS. 5-6 and 7-8), in which a sole 3, 30 made of synthetic material, like any other known sole has a rearfoot region, a forefoot region and a instep region between the rearfoot and the forefoot regions; each of said regions clearly has two respective lateral portions (i.e., side portions) and one medial portion, each of said portions extending in a longitudinal direction of the sole. The stiffening means of these exemplary embodiments includes a one-piece insert consisting of a wire member 4 shaped to define a first end portion A, a second end P and an intermediate portion M (see FIGS. 5-6 and 7-8).

The wire member 4 has a plurality of intermediate bends 4A to define a plurality of wire portions 4B, 4D along the length of the wire member 4. As depicted in FIGS. 5-6 and 7-8, the intermediate portion M of the insert includes a plurality of first intermediate bends 4A of the wire member 4, which define at least one pair of first wire portions 4B arranged side by side in a transverse direction of the sole 3, 30; the first wire portions 4B of the pair are consecutive and separated from each other by a respective intermediate bends 4A; these first wire portions 4B extend in the medial portion of the instep region of the sole 3, 30, in a substantially longitudinal direction of the sole.

As depicted in FIGS. 5-6 and 7-8, the first end portion A of the insert includes a plurality of second intermediate bends 4A of the wire member 4, which define at least one pair of second wire portions 4D arranged side by side in longitudinal direction of the sole 3, 30; the second wire portions 4D of the respective pair are consecutive and separated from each other by a respective

second intermediate bends 4A; these second wire portions 4D extend between the lateral portions of the respective rearfoot and forefoot region, to cross the medial portion thereof, in a substantially transverse direction of the sole 3, 30.

Kosova

Applicant respectfully submits that Kosova does not teach or suggest all of the recitations of new independent claim 18.

Kosova relates to a running shoe, the sole S of which has a longitudinal slot 11, such that the sole is divided into an upper section 15 and a lower section 16. A wire spring 17 engages these upper and lower sections 15, 16 above and below the slot 17, and the spring biases the sections 15, 16 apart. The longitudinal slot 11 extends across the complete width of the sole, from side to side and from the back edge of the shoe to a transverse line 12 located beneath the arch support 10. The upper section 15 has a flat bottom face and the lower section 16 has a flat top face 35. The spring 17 is a one-piece continuous wire of flexible and resilient spring metal having upper and lower halves.

As shown in FIG. 4 of Kosova, the lower half of the spring 17 has opposite sides, each a mirror image of the other. Each side has a laterally inwardly extending segment 18, 18' at its rear end, a bend followed by a short longitudinal segment 19, 19' extending forward, a further bend followed by a short inturned segment 20, 20' extending laterally inward. A further bend is then followed by a longitudinal segment 21, 21' extending forward. After a new bend, a short lateral segment 22, 22' is provided, extending outward from the front end of longitudinal segment 21, 21' parallel to rear segment 18, 18' and lateral segment 20, 20'. After a further bend there is a front longitudinal segment 23, 23', extending forward from the outer end of lateral

segment 22, 22'. The front longitudinal segment 23, 23' is bowed slightly inward, so that it has a convex curvature toward the side of the shoe sole. The front end of segment 23, 23' is connected to an upwardly and reversely bent, rounded segment 24, 24' which connects it to the upper half of the spring.

The upper half of the spring has a front longitudinal segment 25, 25' extending substantially parallel to segment 23, 23', at a short distance above the latter. Segment 25, 25' at its rear end is joined by a bend to a laterally inwardly extending segment 26, 26' which is located a short distance in front of the lateral segment 22, 22' of the lower half of the spring. The inner end of lateral segment 26, 26' is joined to a substantial straight, elongated, longitudinal segment 27, 27' extending rearward and at a slight angle laterally inward to one side of the lower end of a bight segment 28 of inverted U-shape.

Segments 18 and 18' of the lower half of the spring are received in corresponding bores formed in the lower section 16 of the shoe sole. Segments 19 and 19' extend along the outside of the respective side faces 34 and 34' of the lower section of the shoe sole. The front segments 23 and 23' of the spring also extend outside the shoe sole and bear inwardly against the side edges thereof. The curved front segments 25 and 25' similarly bear tightly against the respective adjacent side edges of the shoe sole. The bight 28 at the rear end of the upper half of the spring extends up snugly between the back 30 of the shoe upper U and a strap 31 on the outside of the shoe. The bight 28 passes through a holder loop 32 having a snap fastener 33.

The inherent spring bias of the spring 17 of Kosova causes its upper half to extend upward and rearward from its lower half. Consequently, when positioned on the shoe, the spring 17 biases the upper section 15 of the shoe sole upward from the lower section 16. The upper half

of the spring acts as a “springboard” pivoted at its front end. When this springboard moves down toward the lower section of the shoe, it reduces this downward velocity of the heel and diminishes its impact, as well as storing energy. On the other hand, when the runner's weight shifts from the heel, this stored energy in the spring produces a “catapult-like” upward movement of the upper half of the spring. Thus, the object of the invention of Kosova is to provide a running shoe having a novel spring arrangement for protecting the runner's foot and aiding his or her running performance by providing the runner two phases of assistance, namely a compression phase a retraction phase.

On the other hand, as explained in the description of the application in reference, the arrangement of the “second” wire portions 4D of the insert according to the foot-wear of claim 18 allows for preventing transverse torsions of the respective forefoot or rearfoot region of the sole, while allowing the required resilience; the claimed arrangement of the “first” wire portions 4B of the insert of claim 18 allows for stiffening the instep region of the sole, while allowing a great resiliency of the same region in the longitudinal direction.

The arrangement of Kosova does not allow for opposing any transverse torsion of the sole. To this purpose, it is submitted that the side parts of the spring of Kosova are “joined” to each other only at the bight 28. This bight 28 does not allow for preventing any transverse torsion of the sole, the more considering that such a bight extends outside of the sole of Kosova.

Kosova does not teach or suggest all of the recitations of new claim 18. For instance, the intermediate portion of the spring of Kosova does not includes one pair of wire portions arranged side by side in a transverse direction of the sole, being consecutive and separated from each other by a respective intermediate bend. Similarly, none of the end portions of the spring of Kosova

includes one pair of wire portions arranged side by side in longitudinal direction of the sole, being consecutive and separated from each other by a respective intermediate bends. Also, in Kosova, there are no wire portions extending between the lateral portions of a respective one of the rearfoot and forefoot regions, to cross the medial portion thereof, in a substantially transverse direction of the sole.

Thus, Applicant respectfully submits that independent claim 18 is patentable.

Claim 35

New independent claim 35 is similar to new independent claim 18 but also recites that second end portion P is at the rearfoot region of the sole and includes at least one third wire that crosses the medial portion in a substantially transverse direction.

Applicant respectfully submits that Kosova does not teach or suggest all of the recitations of independent claim 35, for at least the reasons discussed above with respect to independent claim 18.

Dependent Claims

Applicant has also added new dependent claims 19-34, 36, and 37. Applicant respectfully submits that these claims are patentable at least because of their dependency from claim 18 or claim 35.

Claim 19 is supported by the exemplary embodiments shown at FIGS. 5-6 and 7-8, in which the first end portion A of the insert is at the forefoot region of the sole 3, 30, whereas the second end portion P of the insert is at the rearfoot region of the sole. As seen in FIGS. 5-6 and 7-8, the second end portion P of the insert includes at least one third wire portion 4D, extending

between the lateral portions of the rearfoot region, to cross the medial portion thereof, in a substantially transverse direction of the sole 3, 30.

Claim 20 is supported by the exemplary embodiments shown at FIGS. 5-6 and 7-8, in which the sole 3; 30 has an outer peripheral edge and the insert made of the wire 4 does not extend beyond said edge.

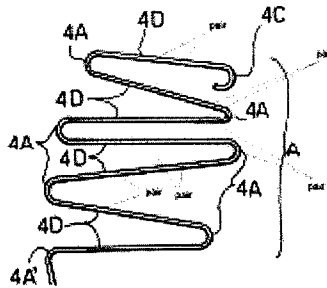
Claim 21 is supported by the exemplary embodiments of FIGS. 5-6 and 7-8 in which the wire member 4 has two longitudinal ends, one being at the first end portion A and the other being at the second end portion P of the insert.

Claim 22 is supported by the exemplary embodiments of FIGS. 5-6 and 7-8, in which the wire member has a respective bend 4C at each end thereof.

Claim 23 is supported by the exemplary embodiments of FIGS. 5-6 and 7-8, in which sole 3; 30 has lower studs 3A; 3B and the insert is arranged such that a plurality of the bends 4A, 4C of the wire member 4 are each at a position corresponding to a respective stud 3A; 3B.

Claims 24 and 25 are supported by the exemplary embodiments of FIGS. 5-6 and 7-8, in which the bends of the wire member 4 are substantially C-shaped or U-shaped bends or V-shaped.

Claim 26 is supported by the exemplary embodiments of FIGS. 5-6 and 7-8, in which the forefoot region A includes at least four bends 4A, and at least five of the wire portions form four pairs (i.e., side by side wires). See Figure below.



Claim 27 is supported by the exemplary embodiments of FIGS. 5-6 and 7-8, in which the intermediate portion M includes two bends 4A, and at least three wire portions forming two pairs.

Claim 28 is supported by the exemplary embodiment of FIGS. 5-6, in which the second end portion P of the insert includes a single third wire portion 4D.

Claim 29 is supported by the exemplary embodiments explained in the description, in which the wire member 4 is a metal wire.

Claims 30-32 are supported by the exemplary embodiment of FIGS. 5-6, in which the first, second and third wire portions are substantially rectilinear, as also explained in the description.

Claims 33 and 34 are supported by the exemplary embodiment in the description, which specifies that the sole is a lower sole or an intermediate sole of the foot-wear.

Claim 36 includes the same limitations as claim 25, while claim 37 includes the same limitations as claim 20.

In addition, to their dependency from independent claims 18 and 35, Applicant provides the following arguments with respect to the dependent claims.

Kosova also fails to meet the limitations of claim 19, provided that the spring thereof has no portion arranged in the forefoot region of the sole. In fact, as mentioned above, spring 17 of Kosova is mounted in the slot 11 of the sole thereof, and this slot extends from the back edge of the shoe to a transverse line 12 located beneath the arch support 10.

Kosova fails to meet the limitations of claim 20 or 37, provided that portions 19, 19', portions 23-25, 23'-25' and portion 28 of the spring thereof extend outside the sole, i.e., beyond the peripheral edge thereof.

Kosova also fails to meet the limitations of claims 21 or 22, since both ends of the spring 17 are in the same forward end portion of the spring, and have no bends.

Similarly, Kosova fails to meet the limitations of claim 23, since the running shoe of Kosova has no studs. Even if the sole of Kosova were equipped with studs, the bends of the spring of Kosova would be in unusual position for studs.

Kosova includes "C" or "U" shaped bends, at 24, 24': however, these bends are not comparable to the claimed "first intermediate bends", being arranged in the medial portion of the instep region of the sole: Bends 24, 24' of Kosova are outside the sole. Thus, Kosova fails to meet the limitations of claim 24. All the remaining bends of Kosova (except for the bend at 28), are "L" shaped bends, such that also the limitations of claims 25 or 36 concerning the shape of the claimed "second intermediate bends" are not met.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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